

Application No. 09/822,228  
Unit: 2625

Amendment under 37 C.F.R. §1.116  
Attorney Docket No.: 010273

### REMARKS

Reconsideration of this application is respectfully requested. Claims 19-36 are pending in this application. Claims 19-36 stand rejected.

#### Claim Rejections – 35 U.S.C. §103

Claims 19-20, 21, 23, 28 and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Tanaka** (USP 6,522,971, previously cited) in view of **Fritsch** (USP 6,247,130, previously cited)

Claims 22 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Tanaka** and **Fritsch** as applied to claims 19 and 20 above, and further in view of **Britt et al.** (USP 6,647,267, previously cited).

Claims 31 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Tanaka** and **Fritsch** as applied to claims 19 and 20 above, and further in view of **Minari** (USP 6,809,831, previously cited).

Claims 32 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Tanaka** and **Fritsch** as applied to claims 19 and 20 above, and further in view of **Kawai** (USP 6,404,994, previously cited).

Claims 26 and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Tanaka** and **Fritsch** as applied to claims 19 and 20 above, and further in view of **Satomi et al.** (US 2004/0039641, previously cited).

Claims 27 and 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Tanaka** and **Fritsch** as applied to claims 19 and 20 above, and further in view of **Hanzawa** (USP 5,506,661, previously cited).

Claims 35-36 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Tanaka**, **Fritsch**, **Minari** and further in view of **Kawai et al.**

All claims, except for claims 35-36, are rejected over the same prior art applied against the claims in the previous Office Action. Claims 35 and 36 were previously rejected over only **Tanaka** and **Fritsch**, and are now rejected over the combination of **Tanaka**, **Fritsch**, **Minari** and **Kawai et al.**

For the reasons set forth in detail below, these rejections are respectfully traversed.

#### **Independent Claims 19 and 20**

In the Response filed on July 13, 2006, it was argued that neither **Tanaka** nor **Fritsch** (nor any of the other cited references) disclose or suggest a method/apparatus as recited in claims 19 and 20 “*wherein it is determined whether a user ID indicates that a user has used the printing agent service in the past, and, based on the determination regarding the user ID, (1) a predetermined number of most recently used printer sites are sent to the client terminal as candidate printing agent printer sites for selection by the user in response to the user ID indicating that the user has used the service in the past, and (2) a nearest printer agent printing site is sent to the client terminal as a candidate for selection by a user when the user ID indicates the user has not used the service in the past.*”

In other words, none of the cited references disclose or suggest the combination of the following features recited in claim 19 (and similarly in claim 20):

*“determining whether the user indicated by the user ID has used the printing agent service in the past;*

*retrieving a predetermined number of most recently used printing agent printer sites selected in the past by the user indicated by the user ID in response to determining that the user indicated by the user ID has used the printing agent service in the past;*

*sending to the client terminal, as candidates for printing agent printer sites to be selected by the user, information indicating the predetermined number of most recently used printing agent printer sites selected in the past by the user indicated by the user ID;*

*receiving location information from the client terminal when the user ID indicates that the user has not used the printing agent service in the past; and*

*retrieving, in response to the location information, a printing agent printer site nearest to a location of the client terminal based on the location information”.*

In the ***Response to Arguments***, the Examiner responds to the previously presented patentability arguments as follows:

Tanaka teaches a service center with a database for storing a user's past [access] history (past accessed services, col. 5, lines 10-33). Tanaka also teaches an example of locating a closest service station based on a user's current geographical location (col. 5, lines 13-17). Tanaka teaches a well-known example of storing history of past [access] to the service center but fails to explicitly indicate which past service station has been used for services (i.e., printing). Fritsch teaches a well-known example of storing and displaying previously used sites for services. Therefore, it would be obvious for Tanaka to store information related to both past

[access] to service center and previously used service station in order to enhance its service (i.e., it would have been obvious to allow the user to [use] the services they have used before without having to remember how to locate them on the network and allows faster access if the user is in a hurry). See Office Action, paragraph bridging pages 9 and 10.

The Examiner apparently recognizes that **Tanaka** does not disclose certain claimed features (i.e., the Examiner states “Tanaka teaches a well-known example of storing history of past [access] to the service center but fails to explicitly indicate which past service station has been used for services (i.e., printing)”).

However, first, referring to Fig. 6 and the related description of **Tanaka**, it can be seen that the access history of **Tanaka** is a history of access to the service center from the user terminal (S1), and whether the user terminal has accessed the service center is determined in S2, before the registration code and password of the user are confirmed (i.e., verified) in S6. *Thus, the history of access is merely a physical communication history, such as a session history, between the **user terminal** and the service center, which is not necessarily associated with a single user.* Accordingly, in using the access history of **Tanaka**, it cannot be determined whether the user has used (i.e., accessed) any of the print agent printer sites from the database in principle.

Second, it should be emphasized that **Tanaka** teaches that the *service center 2* stores a history of access information by each user terminal in order to *determine what sort of guidance screen is displayed* on the user terminal. More specifically, as described in col. 5, lines 26-33 of **Tanaka**, when it is determined that the user terminal has accessed the service center 2 for the

first time, an ***initial guidance screen*** is displayed; when it is determined that the user terminal has accessed the service center in the past, but requests a new service, a ***new guidance screen*** is displayed; when the user terminal requests a service that the user terminal requested in the past, a ***continuative guidance screen*** is displayed.

**Tanaka** fails to disclose or suggest anything regarding storing a history of most recently used printing agent printer sites selected in the past by a user indicated by a user ID and sending these sites to a client terminal as candidate sites in response to determining that a user has used the printing service in the past.

More specifically, **Tanaka** does not disclose or suggest “*retrieving a predetermined number of most recently used printing agent printer sites selected in the past by the user indicated by the user ID in response to determining that the user indicated by the user ID has used the printing agent service in the past; sending to the client terminal, as candidates for printing agent printer sites to be selected by the user, information indicating the predetermined number of most recently used printing agent printer sites selected in the past by the user indicated by the user ID; receiving location information from the client terminal when the user ID indicates that the user has not used the printing agent service in the past; and retrieving, in response to the location information, a printing agent printer site nearest to a location of the client terminal based on the location information, as recited in claim 19 (and similarly in claim 20).*”

It is submitted that using a user’s history of access to a service center 2 to determine what type of guidance screen is displayed for the user in no way suggests the claimed invention. In

fact, **Tanaka** teaches that when a user terminal *requests a service that the user terminal requested in the past*, a continuative guidance screen is displayed. Thus, at best **Tanaka** suggests that the history of access information includes the type of service requested in the past, but in no way suggests that the history includes most recently used service stations.

The Examiner relies on **Fritsch** to teach the deficiencies of **Tanaka**. In the *Response to Arguments*, the Office Action states “Fritsch teaches a well-known example of storing and displaying previously used sites for services.”

First, the Examiner’s characterization of **Fritsch** as teaching “storing and displaying previously used sites for services” is incorrect. **Fritsch** does not teach storing and displaying previously used *sites* for services. **Fritsch** teaches storing a list of all products that the consumer has purchased on a particular Web site. In other words, **Fritsch** teaches storing and displaying a list of products purchased on a single Web site, and does not teach storing and displaying “previously used *sites* for services”.

Thus, **Fritsch** can not alleviate any of the above-noted deficiencies of **Tanaka** because **Fritsch** does not disclose or suggest anything regarding a history of most recently used sites.

As set forth in the Manual of Patent Examining Procedure (MPEP) §2143.03, it is well established that “To establish *prima facie* obviousness of a claimed invention, all the *claim limitations* must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). It is submitted that neither **Tanaka** nor **Fritsch** disclose or suggest the above noted claimed features.

Accordingly, it is respectfully submitted that the rejections of claims 19 and 20, and claims 21-34 dependent therefrom, under §103 are improper and should be withdrawn.

Independent Claims 35 and 36

First, none of **Tanaka, Fritsch, Minari and Kawai et al.** disclose or suggest “wherein if a user specified by the user ID has used any of the printing agent printer site(s) in the past, information of a predetermined number of printing agent printer sites which have been most recently used by the user is sent” as recited in claims 35 and 36.

The Office Action apparently relies on **Fritsch** to teach the above claimed feature (see Office Action, page 8, lines 9-11). However, as discussed above, **Fritsch** is unrelated to and does not disclose sending most recently used **sites** to the user.

The Office Action relies on the **Minari** reference to teach sending print results to a user (see Office Action, page 8, lines 19-20). **Minari** discloses a system wherein a print job from a printer 107 may be received by a host computer connected to a network. However, **Minari** does not disclose or suggest “receiving printing results from any printer at said printer agent printing sites; and automatically debiting a specified account for an agent printing fee in accordance with the received printing results”, as recited in method claim 35 and a server that performs similar functions as recited in claim 36. **Minari** is silent with respect to the aspect of automatically debiting a specified account in accordance with the received printing results (note, the “received printing results” are received from any printer at the printer agent printing sites).

The Office Action relies on **Kawai et al.** to teach the feature of automatically debiting a specified account for an agent printing fee in accordance with received printing results. However, **Kawai et al.** teach a copier capable of receiving a debit card. The debit card of **Kawai et al.** in cooperation with a control unit can debit an account for a user of a *single* printer. If **Kawai et al.** were combined with **Minari**, the result would be that each printer connected to the network in **Minari** would have its own separate debit card system. In other words, none of the references disclose or suggest a system that can receive printing results from any printer at printing agent printer sites and debit a specified account in accordance with the received printing results.

Accordingly, it is respectfully submitted that claims 35 and 36 patentably distinguish over the cited prior art for all of the above reasons. Reconsideration and withdrawal of the rejection of claims 35 and 36 are respectfully requested.

### **CONCLUSION**

In view of the foregoing remarks, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.



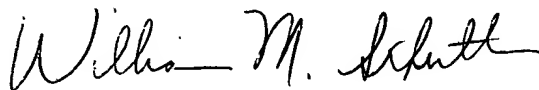
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If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**

A handwritten signature in black ink, appearing to read "William M. Schertler". The signature is fluid and cursive, with the first name "William" and last name "Schertler" being clearly legible, and "M." in the middle.

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